

Appl. No.: 10/662,682
TC/A.U.: 3711 Docket No.: C03-05
Reply to Office Action of November 12, 2004

REMARKS

Claims 1-3, 7-21, 24-39, and 43-56, appear in this application for the Examiner's review and consideration.

Claims 2, 3, and 35, have been amended to correct informalities as directed by the Examiner.

Claims 1, 21, 37, have been amended to include limitations of allowable subject matter.

Claims 7-8, 12-15, 24-27, 43-44, 46, and 48-5, have been amended to recite proper dependent claims.

The Examiner has acknowledged that claims 6, 9, 20, 23, 32, 33, 42, 45, 55, and 56, are directed to allowable subject matter, and would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Independent claim 1, as the base claim for claim 6, has been re-written to include the limitations of claim 6 and intervening claim 5, thereby placing this claim in a position to be allowable.

Independent claim 21, as the base claim for claim 23, has been re-written to include the limitations of claim 23 and intervening claim 22, thereby placing this claim in a position to be allowable.

Independent claim 37, as the base claim for claim 42, has been re-written to include the limitations of claim 42 and intervening claim 41, thereby placing this claim in a position to be allowable.

Claims 4-6, 22-23, and 40-42, have been cancelled without prejudice to Applicants' right to file one or more continuing applications directed to any subject matter not presently claimed.

No new matter has been added by these amendments.

35 USC § 102(b) Rejection Over McKeighen

Claims 1-5, 7, 8, 10-18, 21, 22, 24, 26-31, 34-44, and 46-54, were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,429,365 to McKeighen. McKeighen states that the construction of a golf club head is such that the center of gravity

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is lowered. The Applicants must disagree with the Examiner's assertion that the club head of McKeighen inherently has a center of gravity of at least 5 mm lower than the geometric face or the front face having a point of maximum coefficient of restitution not higher than 2 mm, or preferably 5 mm, below the geometric face center. The McKeighen patent does not suggest any such distances and in the absence of such it would be purely speculative, and considering the inflexibility of his club head as interpreted by the design, it would be highly doubtful.

The Applicants, upon suggestion by the Examiner, have rewritten the base independent claims 1, 21, and 37, to include all the limitations of suggested allowable claims 6, 23, and 42, and their intervening claims. Moreover, the remaining claims 2-4, 7, 8, 10-18, 24, 26-31, 38-40, 43-44, and 46-54, depend from the claims discussed above and add additional features. These claims are believed to be patentable for the totality of the claimed inventions therein and by virtue of their dependence from allowable independent claims. As such, Applicants respectfully request that the rejection to these claims under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

Regarding claim 34, the Applicants must strongly disagree with the Examiner's contention that the club head of McKeighen "inherently" has a spin rate to launch angle ratio of less than about 275 (less than 250 in claim 35) at a geometric face center under robot test conditions. The Applicants have constructed a club head to produce certain launch angle ratios, and have supported their claims with test data provided in FIGS. 8 to 21 of the specification. The Acushnet Company, the assignee of this patent and a manufacturer of top quality golf clubs for more than 50 years, has not demonstrated such launch angle ratios with prior art clubs. To suggest that the extremely inflexible club head as constructed in the McKeighen patent would "inherently" produce these launch angles is very questionable, and in the absence of any supporting prior art not believable.

For claims to be rejected under 35 U.S.C. § 102(b), each and every element as set forth in the claims of the present invention must be found, either expressively or inherently, in a single prior art reference. Applicants respectfully submit that McKeighen does not disclose all the elements of the claimed invention.

Accordingly, independent claim 34 is believed to be in condition for allowance for at least the reasons set forth above. Moreover, the remaining claims 35 and 36 depend from the claims discussed above and add additional features. These claims are believed to be

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patentable for the totality of the claimed inventions therein and by virtue of their dependence from the independent claims. As such, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

35 USC § 102(b) Rejection Over Zebelean

Claims 21, 23, 30, and 31, were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,432,549 to Zebelean. Again, the Applicants see no suggestion that Zebelean would produce a club head having the center of gravity at least 6 mm lower than the geometric face center. Zebelean is a stainless steel club head with virtually no flexibility in the face. The entire face is cast and the club head as shown in the patent does not discuss 0.80 coefficient of restitution, and certainly the center of gravity does not appear to be able to approach 6 mm below the geometric center.

The limitations of claim 23 have been included into the re-written base claim 21, as suggested by the Examiner, placing it into allowance. Claims 30 and 31 depend from claim 21 and add additional features. As such, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejection Over Molitor et al.

Claims 1-4, 16, 17, and 19, were rejected under 35 U.S.C. § 103(a) as being obvious over Molitor et al. (USPN) 4,762,322.

The Examiner has cited Molitor et al. and although Molitor et al. does suggest lowering the specific gravity (as do many club heads in the prior art) Molitor et al. does not specifically claim lowering the center of gravity to the levels of the present patent. The Examiner has concluded that Molitor et al. "inherently" discloses parameters as claimed in the present invention. The Applicants must respectfully disagree with the Examiner's assumptions and the lack of supporting prior art to suggest the limitations of the present invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior

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art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Stating something is "inherent" without any supporting basis fails to cure the deficiencies of *Molitor et al.* There is no motivation to modify *Molitor et al.*

The Applicants, as stated above, have rewritten independent claim 1 to reflect all the limitations of allowable claim 6 and the intervening claim 5. This would appear to make this rejection of claim 1 moot in light of this amendment.

The rejection under 35 U.S.C. § 103(a) is believed to have been overcome for at least the above reasons. Applicants respectfully request reconsideration and withdrawal thereof.

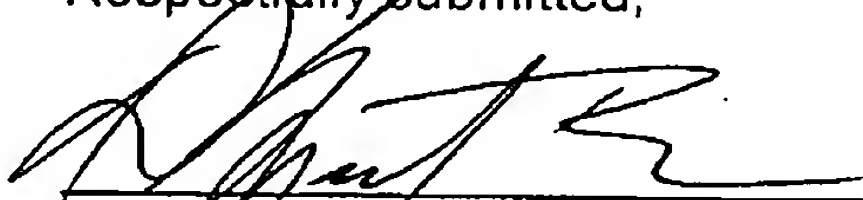
Conclusion

Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' agent would further the prosecution of this application, the Examiner is encouraged to call the agent at the number below.

No fee is believed to be due for this submission. However, should any required fees be due, please charge them to Acushnet Company Deposit Account No. 502309.

Jan 3, 2005
Date

Respectfully submitted,


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